

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOEL VATSKY

Appeal No. 99-0029
Application 08/595,967¹

ON BRIEF

Before CALVERT, MEISTER and ABRAMS, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 29 to 32, all the claims remaining in this application.²

¹ Application for patent filed February 6, 1996.

² We note that in his brief appellant requests an oral hearing, but under the circumstances a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence, as amended effective Dec. 1, 1997 (62 F.R. 53131 (Oct. 10, 1997)), 1203 O.G. 63 (Oct. 21, 1997)), and MPEP § 1209

The claims on appeal are drawn to a burner assembly, and are reproduced in the appendix to appellant's brief.

The references applied in the final rejection are:

Henderson et al. (Henderson)	3,753,658	Aug. 21, 1973
Hess	5,060,984	Oct. 29, 1991
Vatsky	5,347,937	Sep. 20, 1994

Claims 29 to 32 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Vatsky in view of Hess and Henderson.

Since appellant states on page 3 of the brief that claims 29 to 32 are in the same group, we select independent claim 29 from the group and shall decide the appeal based thereon. 37 CFR § 1.192(c)(7).³

The basis of the rejection is stated on pages 3 to 6 of the examiner's answer, and need not be repeated here.

First considering the Hess reference, appellant argues that it would not have been obvious to employ the low wear elbow disclosed therein with the Vatsky burner apparatus, essentially because there would have been no suggestion or motivation to do so. According to appellant, the only basis for

(July 1998).

³ In reviewing the claims, we note that the term "splitters" in claim 29, line 11 and claim 32, line 1, does not appear to have antecedent basis in the specification, as required by 37 CFR § 1.75(d)(1).

combining Vatsky and Hess would be the result of hindsight derived from appellant's own disclosure.

We do not agree. In the Vatsky apparatus, the fuel, consisting of pulverized coal suspended in air, enters at 28 and swirls through chamber 26, being discharged through member 24 in a direction which is at a right angle to the direction in which it was introduced (col. 5, lines 38 to 42, and Fig. 1). Hess discloses that when granular or particulate particles being transported through a conduit must make a sharp right angle turn, the wall of the elbow opposite the entry port will be rapidly eroded (col. 1, lines 14 to 25). To overcome this problem, Hess teaches that the elbow should be constructed as shown in Fig. 1, for example, with a chamber 20 for swirling a portion of the particles entering at port 12. Since the incoming particulate coal particles in the Vatsky apparatus must make a sharp right angled turn, as shown in Fig. 1, one of ordinary skill would have found it obvious to use an elbow with a swirl chamber, as disclosed by Hess, in order to minimize erosion at that point. The motivation or suggestion to modify the Vatsky apparatus in this manner would come not from appellant's disclosure, but from the teachings of Hess of the advantage thereof.

Turning to Henderson, appellant argues that this patent is nonanalogous art, and that it would not have been obvious therefrom to provide the Vatsky burner with a conical vane, as claimed.

It is unnecessary to resolve the question of whether Henderson is nonanalogous art, for even assuming that it is analogous, we do not consider that it would have suggested the claimed conical vane.

Henderson discloses apparatus for making carbon black in which oil is discharged through nozzle 8 and fuel and air are introduced into axial zone 1. The examiner notes that Henderson discloses a cone 20 positioned around the conduit 6 leading to nozzle 8, and asserts that in view thereof it would have been obvious to dispose a conical vane around Vatsky's burner tubular member 24/24a. However, we note that Henderson's cone is longitudinally movable relative to conduit 6, and the disclosed function of the cone is to direct a portion of the reactants in axial zone 1 across the oil nozzle 8, thereby "changing the structure of the carbon black produced" (col. 6, lines 26 to 28) or "influenc[ing] the quality of the carbon black produced" (col. 5, lines 66 and 67). It is not evident to us why this disclosure would have taught or suggested to one skilled in the art placing a conical vane around the burner of Vatsky, since Vatsky is not concerned with making carbon black (or any product), but simply with burning particulate coal. In this instance, we agree with appellant that such a modification of Vatsky would be the result of impermissible hindsight.

On page 6 of the answer, the examiner asserts that "In general, conical vanes disposed around a fuel-conveying conduit in a burner are well-known in the art," but the only evidence cited in support of this assertion is Henderson, which, as discussed above, discloses using a conical vane only for the specific purpose of changing or influencing the structure or quality of carbon black being produced, rather than containing a broad teaching consonant with the examiner's assertion. A rejection based on 35 U.S.C. § 103 must rest on a factual basis, rather than speculation, unfounded assumptions or

hindsight reconstruction.

In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The examiner also takes the position that even in the absence of Henderson, Vatsky would meet the "conical vane" limitation of claim 29 because it discloses "conical vanes or plates (68)" (answer, page 5) and "segments of conical vanes or plates (68)" (id., page 7). This is not persuasive because claim 29 requires a conical vane, not segments of a conical vane, or plates spaced around the circumference of the burner 24a, as shown by Vatsky.

Accordingly, the rejection of claim 29, and therefore of claims 30 to 32, will not be sustained.

Conclusion

The examiner's decision to reject claims 29 to 32 is reversed.

REVERSED

IAN A. CALVERT
Administrative Patent Judge

JAMES M. MEISTER
Administrative Patent Judge

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